

## **2. REMARKS / DISCUSSION OF ISSUES**

Claims 1-15<sup>1</sup> were rejected under 35 U.S.C. § 103(a) as allegedly being obvious over *Kraus, Jr., et al.* (U.S. Patent 6,470,220) and *Wang, et al.* (U.S. Patent 6,940,286). For at least the reasons set forth below, Applicants respectfully submit that all claims are patentable over the applied art.

### **A. The applied art fails to disclose all features of claim 1**

A *prima facie* case of obviousness has three requirements. First, the prior art relied upon, coupled with the knowledge generally available in the art at the time of the invention, requires some reason that the skilled artisan would modify a reference or to combine references.<sup>2</sup> The Supreme Court has, however, cautioned against the use of “rigid and mandatory formulas” particularly with regards to finding reasons prompting a person of ordinary skill in the art to combine elements in the way the claimed new invention does.<sup>3</sup> But rather the Supreme Court suggests a broad, flexible “functional approach” to the obviousness analysis recognizing that “[i]n many fields it may be that there is little discussion of obvious techniques or combinations.”<sup>4</sup> Second, the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the same time the invention was made. In other words, a hindsight analysis is not allowed.<sup>5</sup> Lastly, the prior art

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<sup>1</sup> The undersigned notes that claim 15 was listed in the rejection on page 2 of the Office Action. This appears to be a typographical error as claim 15 was not elected for examination at this time and was cancelled. Clarification is respectfully requested.

<sup>2</sup> See *Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, 411 F.3d 1332 (Fed. Cir. 2005) (“[S]imply identifying all of the elements in a claim in the prior art does not render a claim obvious.”).

<sup>3</sup> See *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007) (“The obviousness analysis cannot be confined by a formalistic conception of the words teaching, suggestion, and motivation, or by overemphasis on the importance of published articles and the explicit content of issued patents.”).

<sup>4</sup> Id. See also Id. at 1743 F. 3d 1356 (Fed. Cir. 2006) (“Our suggestion test is in actuality quite flexible and not only permits, but *requires*, consideration of common knowledge and common sense”) (emphasis in original).

<sup>5</sup> See *Amgen, Inc. v. Chugai Pharm. Co.*, 927 F.2d 1200 (Fed. Cir. 1991) (“Hindsight is not a justifiable basis on which to find that ultimate achievement of a long sought and difficult scientific goal was obvious.”).

reference or combination of references must teach or suggest all the limitations of the claims.<sup>6</sup>

i. Claim 1:

Claim 1 recites:

*A device (1) for examination and use of an electrical field in a magnetic gradient field, containing magnetic particles in an examination area of an object under examination, comprising*

- a. at least one first arrangement (2) for determining the spatial distribution of magnetic particles in at least one examination area of the object under examination, comprising a means (14) for generating a magnetic field with such a spatial magnetic field strength profile that a first sub-zone with low magnetic field strength and a second sub-zone with higher magnetic field strength are produced in at least one examination area, a means for detecting signals which depend on the magnetization in the object under examination, especially in the examination area, influenced by a local change in the particles, together with a means for evaluating the signals to obtain information about the, especially time-variable, spatial distribution of the magnetic particles in the examination area; and*
- b. at least one second arrangement (8), comprising **at least one electrical transmit and/or receive unit (6), comprising at least one voltage generator (22), at least one terminal contact (18) connected to the voltage generator and applicable and/or fastenable to an object under examination, and a ground terminal (20) applicable and/or fastenable to an object under examination.***

In rejecting claim 1, the Office Action concedes that *Kraus, Jr., et al.* fails to disclose ‘the second arrangement’ and turns to *Wang, et al.* in an attempt to cure the conceded deficiency in *Kraus, Jr., et al.* While Applicants do not necessarily concur that *Kraus, Jr., et al.* teaches all features of claim 1 asserted in the Office Action, Applicants

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<sup>6</sup> See *In re Wilson*, 424 F.2d 1382 (C.C.P.A. 1970) (“All words in a claim must be considered in judging the patentability of that claim against the prior art.”).

nonetheless respectfully submit that a proper rejection for obviousness has not been established for at least the reasons set forth below.

In rejecting claim 1, the Office Action directs Applicants to Fig. 1, the Abstract and column 4, lines 60-65 of *Wang, et al.* for the alleged disclosure of the features of the second arrangement of claim 1. Applicants respectfully demur. Notably, while the Abstract, Fig. 1 and column 4, lines 60-65 do disclose electrical excitation sources 4, which in column 5 are denoted as voltages, there is no disclosure of a *transmit and/or receive unit comprising a voltage source*, as specifically recited in claim 1. Applicants note that while a number of “electrical excitation sources, such as current or voltages 4, are applied to one or more electrical contacts 2” is disclosed at column 5, lines 15-20 of *Wang, et al.*, these are not a part of a transmit and/or receive unit as specifically recited in claim 1.

Furthermore, the Office Action asserts that the featured ground terminal is a matter of design choice, for safety purposes to prevent the electrocution of the patient during examination. This assertion is flawed for at least two reasons.

First, claim 1 recites *a ground terminal (20) applicable and/or fastenable to an object under examination*. By the Examiner’s reasoning for design selection, the selection of the object under examination would not be connected to the ground, but rather connected elsewhere to ensure preventing current from traveling through the patient for safety purposes. Thus, the Examiner’s rationale of using preventing electrocution of a patient would direct one skilled in the art to not connect the ground terminal to the patient for safety’s sake; whereas claim 1 specifically features this connection.

Second, a claim rejection must be based on **objective evidence** of record, and cannot be supported merely on subjective belief and unknown authority.<sup>7</sup> In the present case, the Examiner asserts that the ground terminal is merely a design choice. While reference is made to the dictionary definition of a “ground” there is no evidence

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<sup>7</sup> See, e.g., M.P.E.P. § 2144.03; *In re Lee*, 277 F.3d at 1344-45, 61 USPQ2d at 1434-35 (Fed. Cir. 2002); *In re Zerko*, 258 F.3d at 1386, 59 USPQ2d at 1697.

presented as to why this substantiates the claim of design choice set forth in the Office Action. Furthermore, and as noted above Examiner's rationale of using preventing electrocution of a patient would direct one skilled in the art to not connect the ground terminal to the patient for safety's sake; whereas claim 1 specifically features this connection.

Accordingly, Applicants again respectfully submit that no concrete evidence supporting this position has been provided by the Examiner here, nor did the Examiner submit an affidavit as required by 37 C.F.R. § 1.104(d)(2) if this proposed motive of design choice were based on facts within his personal knowledge (see M.P.E.P. § 2144.03). Applicants respectfully request that such an affidavit be provided if a rejection continues to be made without a citation of any objective evidence.

For at least the reasons set forth above, Applicants respectfully submit that the applied art fails to disclose at least one feature of claim 1. Therefore, a *prima facie* case of obviousness has not been established, and claim 1 is patentable over the applied art. Moreover, claims 2-14, which depend immediately or ultimately from claim 1, are patentable for at least the reasons set forth below.

**Conclusion**

In view the foregoing, applicant(s) respectfully request(s) that the Examiner withdraw the objection(s) and/or rejection(s) of record, allow all the pending claims, and find the application in condition for allowance.

If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted on behalf of:  
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